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OFFICE OF PETITIONS

In re Application of:
Konecke
Filed: 22 May, 2000
Application No. 09/575,429
Docket No. APOG1.005A

ON PETITION

This is a decision on the petitions filed herein on 7 April, 2003, under 37 C.F.R. §1.137(a)¹ and §1.137(b)² to revive the above-identified application, and considered, in light of Petitioner's

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

allegations of non-receipt under 37 C.F.R. §1.181³ as a request to withdraw the holding of abandonment.

The petition:

- under 37 C.F.R. §1.137(b) is **GRANTED**;
- under 37 C.F.R. §1.137(a) is **DISMISSED**; and
- as considered under 37 C.F.R. §1.181 is **DISMISSED**.

BACKGROUND

The record indicates that:

- applicant failed to file a timely and proper response to the final Office action mailed on 5 August, 2002, with a reply due (absent extension of time) on or before 5 November, 2002;
- while Petitioner alleges that the Office lost his reply filed by him on Monday, 7 October, 2002, he provides no date-stamped receipt card evidencing receipt of the reply by the office;
- on 3 February, 2003, Petitioner submitted via FAX a copy of his reply;
- however, Petitioner's reply was not a proper reply;⁴

³ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * * (Emphasis supplied.)

⁴ The proper response to the final Office action (see: Fn. 1, item (1); MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a request for continued examination (RCE) under 37 C.F.R. §1.114 or a continuing application.

- on 24 February, 2003, the Examiner issued an Advisory Action indicating that the amendment failed to place the application in condition for allowance;

- Petitioner alleges that thereafter he:

--engaged in a number of discussions with the Examiner wherein the Examiner first indicated that he would extend the deadline for reply and then indicated that he could not do so, and

--then discussed the matter with the Examiner's supervisor, who, Petitioner states, based her refusal to extend the reply period on regulatory constraints,

however, this is of no matter because Petitioner, as a registered practitioner of many years before the Office is aware that the maximum statutory period for reply is six (6) months;

- contemporaneously with the instant petitions (with fee), Petitioner filed a request for continued examination (with fee) and submission in the form of an amendment.

Notably, Petitioner pleads petitions under both 37 C.F.R. §1.137(a) and §1.137(a)--and also requests that the fee for the petition under 37 C.F.R. §1.137(a) be refunded if the petition is dismissed.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁵

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁶

⁵ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁶ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.⁷ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁸

And the Petitioner must be diligent in attending to the matter.⁹

(Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.¹⁰ The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.¹¹ Such does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹²))

As to the Request to Withdraw
the Holding of Abandonment and
the Allegation of Unavoidable Delay

Petitioner submits no showing as the basis for the petition to withdraw the holding of abandonment or as to the petition alleging unavoidable delay, save that Petitioner submitted a reply that was not a proper reply, and then waited until the end of the statutory period to raise the matter with the Examiner.

Because the error was not that of the Office, withdrawal of the holding of abandonment is not proper in the premises.

Moreover, because Petitioner's actions do not evidence the diligence required under Pratt,

⁷ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁸ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

¹⁰ See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹¹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

¹² Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Petitioner fails to satisfy the "showing" requirement as to allegation of unavoidable delay.

Thus, Petitioner's failure to satisfy the "showing" requirements under the regulations precludes withdrawal of the holding of abandonment or revival of the instant application as having gone abandoned due to unavoidable delay.

As to Unintentional Delay

Petitioner has authorized the fee, made the statement of unintentional delay, and submitted authorization for the required reply(ies).

CONCLUSION

Accordingly, the petition:

- to revive under 37 C.F.R. §1.137(b) hereby is **granted**;
- to revive under 37 C.F.R. §1.137(a) must be and hereby is **dismissed**; and
- as considered under 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

Petition fees are jurisdictional--the petitions pled were considered, and therefore the fees will not be refunded.

The instant application is being forwarded to Technology Center 1700 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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